

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : MARK J. LEVINE ET AL.

Serial No. : 10/730,459

For : HYDROENTANGLING USING A FABRIC
HAVING FLAT FILAMENTS

Filed : DECEMBER 8, 2003

Examiner : ANDREW T. PIZIALI

Art Unit : 1794

Confirmation No. : 2911

PETITION FROM REQUIREMENT FOR RESTRICTION UNDER 37 C.F.R. § 1.144

Mail Stop Petition

November 25, 2009

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Petition from a Requirement for a Restriction is filed in response to the Office Action dated August 25, 2009 (Paper No. 20090821) in which the Examiner made the Restriction Requirement Final.

REMARKS

This petition is filed after a final requirement for restriction dated August 25, 2009.

The facts in the case are as follows:

1. A restriction requirement was issued on September 19, 2005, in which the Applicant was required to elect for further prosecution on the merits from two groups of claims: Group I - Claims 1-14 and 23-30, drawn to a hydroentangling support fabric, classified in class 442, subclass 337. Group II - Claims 15-22, drawn to a method of producing a support fabric, classified in class 139, subclass 97.

2. In a response dated October 19, 2005, Applicant elected, without traverse, Group I claims 1-14, and 23-30 drawn to a hydroentangling support fabric, for further prosecution in the present application. Claim 1 as originally drafted recited: "A hydroentangling support fabric comprising flattened filaments." Claim 23 recited: "A support fabric for a hydroentangling process, produced by incorporating flattened filaments during production of said support fabric."

3. After numerous rounds of prosecution, in an Amendment dated April 13, 2007, claim 1 was amended to recite: "A hydroentangling support fabric in combination with a hydroentangling device for the production of a hydroentangled nonwoven product, said support fabric comprising flat filaments, wherein said support fabric is in a continuous loop or made endless." This claim was subject to examination on the merits in the Final Office Action dated May 31, 2007. No restriction/election requirement was made.

4. In an Amendment dated May 5, 2008, claim 1 was amended to recite: "A hydroentangling support fabric for use in a hydroentangling device for the production of a hydroentangled nonwoven product, said support fabric comprising flat filaments, wherein said

support fabric is in a continuous loop or made endless." This claim was subject to examination on the merits in another Final Office Action dated July 03, 2008. No restriction/election requirement was made.

5. An Amendment dated October 3, 2008, was filed in response to the July 3, 2008 Final Office Action. Claims 1 and 23 were amended as follows:

1. (Currently Amended) ~~A hydroentangling support fabric for use in a hydroentangling device~~ A hydroentangling apparatus for the production of a hydroentangled nonwoven product comprising, said

a hydroentangling support fabric comprising flat filaments, and wherein said support fabric is in a continuous loop or made endless.

23. (Currently Amended) A support fabric ~~in a hydroentangling apparatus for a hydroentangling process carried out on a hydroentangling device~~, said support fabric comprising flat filaments, wherein said flat filaments are incorporated into said support fabric during production of said support fabric, and wherein said support fabric is in a continuous loop or made endless.

6. The Examiner issued an Advisory Action on October 8, 2008 refusing to enter the amendment.
7. A Request for Continued Examination was filed on October 24, 2008.

8. A Non-Final Office Action was issued on January 8, 2009. In response to Applicant's prior amendments withdrew claims 1-13 from consideration as being directed toward a non-elected invention under 35 U.S.C. 121 and 37 C.F.R. § 1.142, alleging the amended claims were related as a subcombination and combination distinct from the originally elected invention. The Examiner "noted that claims 3, 5 and 9-12 were also drawn to a non-elected species."
9. On February 10 and 11, 2009, Applicants' representatives conducted a telephonic interviews with the Examiner, where Applicant's representative traversed the Election/Restriction requirement. During the interview, the Examiner stated that the restriction of amended claims 1-13 was made as against then pending claim 23, because claim 23 recited "said flat filaments are incorporated into said support fabric during production of said support fabric...." Applicants representative explained that a restriction based on an non-elected invention, as articulated in the prior Office Action, is not properly made as against a pending claim, but is to be made based on the originally elected invention.
10. On April 3, 2009, Applicant filed an Amendment that traversed the Examiner's restriction/election, and argued that the restriction/election based on a combination/subcombination as improper, as well as the fact that no extra search burden was required.
11. In the April 2009 Amendment, claim 1 was also amended to recite: "A hydroentangling apparatus for the production of a hydroentangled nonwoven product, the improvement comprising: a hydroentangling support fabric comprising flat filaments, wherein said support fabric is in a continuous loop or made endless." Claim 23 was amended to recite: "[[A]] An improved hydroentangling support fabric in a hydroentangling apparatus for-

hydroentangling process production of a hydroentangled nonwoven product, said support fabric the improvement comprising; said hydroentangling support fabric comprising flat filaments, wherein said flat filaments are incorporated into said support fabric during production of said support fabric, and wherein said support fabric is in a continuous loop or made endless.”

12. A Supplemental Amendment correcting the status identifiers of the claims was filed on July 17, 2009

13. In another Final Office Action dated August 25, 2008, the Examiner made the restriction Final.

14. In the August 2008 Final Office Action at page 2, responding to the traversal, the Examiner stated: “prior to the current amendment, the combination did not require the subcombination requirement that the flat filaments be incorporated into the support fabric during production of the support fabric. After the current amendment applicant’s argument is still not persuasive because the combination does not require that the hydroentangling support fabric be in a hydroentangling apparatus.”

This petition is filed in which the Applicant respectfully requests the Director withdraw the Examiner’s restriction/election and reissue the Office Action dated August 25, 2009, in which pending claims 1-2, 4, 6-8, 13, 23, and 25-27 are examined (claim 3, 5, 9-12, 24, and 28-29 being withdrawn prior to this restriction).

First, the restriction is improper because the alleged combination and subcombination are not distinct inventions as the claimed combination requires the particulars of the subcombination to be patentable. In particular, the claimed combination, hydroentangling apparatus comprising the hydroentangling support fabric comprising flattened filaments,

requires the particulars of the subcombination, the hydroentangling support fabric comprising flat filaments, to be patentable.

The Interview Summary mailed on February 11, 2009, the Examiner states:

The examiner indicated that the argument was not persuasive because the phrase ‘as claimed for patentability’ is present merely to acknowledge that the particulars of the subcombination are claimed for the purpose of obtaining a patent, **not** that the particulars must be novel characteristic(s) of the claim. (Emphasis added)

This is clear error. First, it should be noted that any patent application or claim filed with the Patent Office is “for the purpose of obtaining a patent.” Thus, the Examiner’s interpretation would render the phrase “as claimed for patentability” extraneous and irrelevant.

Moreover, the Examiner’s interpretation is inconsistent with the language of the MPEP. MPEP 806.05(c), which states, *inter alia*:

To support a requirement for restriction between combination and subcombination inventions, **both two-way distinctness and reasons for insisting on restriction are necessary**, i.e., there would be a *>serious< search burden >if restriction were not required< as evidenced by separate classification, status, or field of search. See MPEP § 808.02.

The inventions are distinct if it can be shown that a combination as claimed:

(A) **does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and**

(B) the subcombination can be shown to have utility either by itself or in another materially different combination.

When these factors cannot be shown, such inventions are not distinct. (Emphasis added)

Therefore, in order to support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary. The MPEP clearly states that the phrase “claimed for patentability” is to show “novelty” and “unobviousness.” Therefore, with all due respect, the Examiner has misinterpreted the teachings of the MPEP in the Election/Restrictions argument.

MPEP 806.05(c) illustrates an example, where a subcombination is essential to the combination, such as in the instant case, in that:

AB_{sp}/B_{sp} No Restriction

Where a combination *as claimed* > requires< the details of *>a< subcombination *as separately claimed*, there is >usually< no evidence that combination AB_{sp} is patentable without the details of B_{sp}. **The inventions are not distinct and a requirement for restriction must not be made or maintained, even if the subcombination has separate utility.** This situation can be diagrammed as combination AB_{sp} (“sp” is an abbreviation for “specific”), and subcombination B_{sp}. Thus the specific

characteristics required by the subcombination claim B_{sp} are also required by the combination claim. (Emphasis added)

As indicated above, the claimed combination, hydroentangling apparatus comprising the hydroentangling support fabric, requires the particulars of the claimed subcombination, the hydroentangling support fabric with flat filaments, for patentability (to show novelty and unobviousness), and therefore the inventions are not distinct and a requirement for restriction must not be made or maintained, even if the subcombination, the hydroentangling support fabric, has separate utility.

In this connection, MPEP 808.02 states, *inter alia*:

Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121 is never proper (MPEP § 806.05).

Accordingly, the Examiner's restriction requirement is improper and should be withdrawn.

Next, Applicant respectfully points out that MPEP § 811 states that the Examiner will consider whether there will be a serious burden if restriction is not required. The originally elected invention for prosecution was Group I claims 1-14, and 23-30 drawn to a hydroentangling support fabric. Claim 1 as originally drafted recited: "A hydroentangling support fabric comprising flattened filaments." Claim 23 recited: "A support fabric for a hydroentangling process, produced by incorporating flattened filaments during production of said support fabric." Applicant respectfully points out that there can be no serious burden, as the claims have been amended to recited a Jepson format to concede that a hydroentangling apparatus is known in the art: "A hydroentangling apparatus for the production of a

hydroentangled nonwoven product, **the improvement comprising: a hydroentangling support fabric comprising flat filaments, wherein said support fabric is in a continuous loop or made endless.**" See MPEP 2129. Thus it cannot be said that the amendments made to the claims in the amendment filed on April 3, 2009 separate the claims into distinctly separate groups of sub-combinations which were never previously examined or rejected.

Moreover, as is evident, the language presently following "the improvement comprising" in claim 1 (as well as the recitations before the language) has already been subject to full examination on the merits. Claim 1 **always** recited a **hydroentangling** support fabric including flattened filaments, reciting: "A hydroentangling support fabric comprising flattened filaments" as originally presented. Moreover, the claims had been amended and subject to Examination on the merits for: "A hydroentangling support fabric for use in a hydroentangling device for the production of a hydroentangled nonwoven product, said support fabric comprising flat filaments, wherein said support fabric is in a continuous loop or made endless" (claim 1 as amended in the Amendment of May 5, 2008, subject to examination on the merits in the Final Office Action dated July 03, 2008) and "A hydroentangling support fabric in combination with a hydroentangling device for the production of a hydroentangled nonwoven product, said support fabric comprising flat filaments, wherein said support fabric is in a continuous loop or made endless"(claim 1, as amended in the Amendment of April 13, 2007, subject to examination on the merits in the Final Office Action dated May 31, 2007).

Thus in every Office Action after the Applicants initial election, a hydroentangling support fabric with flat filaments has been examined. Thereafter "a hydroentangling support fabric comprising flat filaments, wherein said support fabric is in a continuous loop or made endless," as well as express recitations of a hydroentangling support fabric used with or in

combination with “a hydroentangling device.” Thus at no point could the Examiner fairly argue that the examination of “A hydroentangling apparatus for the production of a hydroentangled nonwoven product, **the improvement comprising: a hydroentangling support fabric comprising flat filaments, wherein said support fabric is in a continuous loop or made endless,**” as presently recited, represents an undue search burden as each of the recited elements have been subject to search and examination on the merits.

Finally, during the interviews February 10 and 11, 2009, the Examiner stated that the restriction of amended claims 1-13 was made as against then pending claim 23, because claim 23 recited “said flat filaments are incorporated into said support fabric during production of said support fabric....” Applicants representative explained that a restriction based on an non-elected invention, as articulated in the prior Office Action, is not properly made as against a pending claim, but is to be made based on the originally elected invention. Nonetheless, in the April, 2009 Amendment, claim 23 was also amended to delete the language: “wherein said flat filaments are incorporated into said support fabric during production of said support fabric, and wherein said support fabric is in a continuous loop or made endless.” In the August 2008 Final Office Action at page 2, responding to the traversal, the Examiner stated: “prior to the current amendment, the combination did not require the subcombination requirement that the flat filaments be incorporated into the support fabric during production of the support fabric. After the current amendment applicant’s argument is still not persuasive because the combination does not require that the hydroentangling support fabric be in a hydroentangling apparatus.” Thus the quote shows the duplicate restrictions are in each case based on the language of pending claim 23, not based on the originally elected invention. This is clear error (aside from representing a new ground of restriction) as the as the restriction does not consider the originally elected

invention as a basis but looks only to pending claim 23 – an improper basis for a restriction based on an election by way of original presentation.

Applicant respectfully submits that the restriction is improper under 35 U.S.C. 121 and 37 C.F.R. § 1.142. Therefore, Applicant respectfully requests that this petition be granted, the restriction requirement withdrawn and a new Office Action examining pending claims 1-2, 4, 6-8, 13, and 23-27 should be issued (claims 3, 5, 9-12, 24, and 28 being withdrawn).

Applicant respectfully submits that no petition fee is required for this Petition. However, in the event that the Director deem otherwise, any fees that may be due with respect to this paper, the Commissioner is authorized to charge our Deposit Account 50-0320.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicant respectfully petitions for an appropriate extension of time. The fees for such extension of time may be charged to Deposit Account No. 50-0320.

In the event that any additional fees are due with this paper, please charge our Deposit Account No. 50-0320.

Respectfully submitted,

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Date: November 25, 2009

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